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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,080	02/05/2002	Christian Fritz	06286-090002	7540

26161 7590 01/02/2003

FISH & RICHARDSON PC  
225 FRANKLIN ST  
BOSTON, MA 02110

EXAMINER
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SHAHNAN SHAH, KHATOL S

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 01/02/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/068,080

File copy  
Applicant(s)

FRITZ ET AL.

Examiner

Khatol S Shahnan-Shah

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicants' preliminary amendment of February 5, 20021, paper No. 3 is acknowledged. Claims 1-38 were canceled. New claims 39-40 were added. Specification pages 1 and 11 were amended.
2. Claims 39-40 are pending and under consideration.

#### ***Drawings***

3. The drawings are approved by the Draftsperson.

#### ***Priority***

4. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

Complete priority statement is missing from specification:

Applicants amendment of February 5, 20021, paper No. 3 is not complete because the current status of the parent application(s) is not included. A claim for priority under 35 U.S.C. 119 (a) (d) (e) cannot be based on said application, until proper corrections are made.

#### ***Specification***

5. The disclosure is objected to because of the following informalities:

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see page 14). Applicants are required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 39- 40 are vague and indefinite because they recite a composition identified by a method, which comprises contacting a test compound with a polypeptide, which is only identified by a name, i.e., S-ynes. The mere recitation of a name does not adequately define the polypeptide to be used in the claimed method. The claim should provide any structural properties, such as the amino acid sequence of the polypeptide (SEQ ID NO) and/or molecular weight, source and function of the polypeptide, etc., which allow one to identify the protein without ambiguity. The use of S-ynes to identify the polypeptide leaves the claim vague and indefinite.

Claims 39-40 are vague and indefinite because it is unclear what is encompassed by the recitation of “interaction”. Is this interaction binding or biochemical activity, etc? Clarification is requested.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 39-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Davies (US Patent 3,681,493).

The claims are drawn to a composition comprising an antibacterial agent and a pharmaceutically acceptable excipient or carrier, the antibacterial agent being prepared by the claimed method.

Note: The claims are product by process claims. The purification or production of a product by a particular process does not impart novelty or unobviousness to a product, when the product is taught by the prior art.

Davies discloses antibacterial pharmaceutical compositions comprising an antibacterial agent and a pharmaceutically acceptable excipient or carrier (see claims and abstract).

The products of the prior art reference appear to be the same as the claimed product because they appear to possess the same functional characteristics, i.e. (antibacterial). The purification or production of a product by a particular process does not impart novelty or unobviousness to a product when the same product is taught by the prior art. This is particularly true when the properties of the product are not changed by the process in an unexpected manner. See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972).

8. Claims 39-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Currie et al. (US Patent 4,963,569).

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The claims are drawn to a composition comprising an antibacterial agent and a pharmaceutically acceptable excipient or carrier, the antibacterial agent being prepared by the claimed method.

Note: The claims are product by process claims. The purification or production of a product by a particular process does not impart novelty or unobviousness to a product.

Currie et al. disclose antibacterial pharmaceutical compositions comprising an antibacterial agent and a pharmaceutically acceptable excipient or carrier (see claims and column 1, lines 35-65).

The products of the prior art reference appear to be the same as the product claimed by the applicant because they appear to possess the same functional characteristics, i.e. (antibacterial). The purification or production of a product by a particular process does not impart novelty or unobviousness to a product when the same product is taught by the prior art. This is particularly true when the properties of the product are not changed by the process in an unexpected manner. See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972).

### ***Conclusion***

9. No claim is allowed.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chalet et al. US 4,670,466

Wagatsuma et al. US 4,576,938

Hernandez et al. US 4,311,693

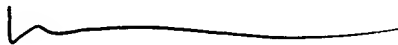
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Stapley et al. US 3,927,210

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khatol S Shahnan-Shah whose telephone number is (703) 308-8896. The examiner can normally be reached on 7:30am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.




Khatol Shahnan-Shah, BS, Pharm, MS

Biotechnology Patent Examiner

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December 27, 2002

  
**LYNETTE R. F. SMITH**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**